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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/573,015

03/22/2006

Markus Gisler

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CLARIANT CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
4000 MONROE ROAD
CHARLOTTE, NC 28205

EXAMINER

POWERS, FIONA

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

06/02/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/573,015	Applicant(s) GISLER, MARKUS	
	Examiner Fiona T. Powers	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-15 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims 1 to 10 and 12 to 15 are pending in the application.

Receipt is acknowledged of the preliminary amendment filed March 22, 2006, which has been entered in the file.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

No information disclosure statement has been filed in this application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the

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invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 to 3, 5 to 10 and 12 to 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Carr (GB 23317570, cited.

The reference discloses the claimed compound of the formula (1) wherein B and B' are SO₃H and are ortho to the diazo bridge; Q is an alkylene group; R, R', R'' and R''' are each H; and X and X' are each a labile atom or group such as Cl. Note Example 2, in particular where Z¹ IS Cl and Dye Nos. 2-4, 10 and 11 of Table 1, and Tables 2 and 3. The reference also discloses that the compounds can be used for dyeing or printing hydroxy- and/or nitrogen-containing substrates such as cotton, wool and paper and in the preparation of inks. Note the abstract and page 13, lone 35 to page 14, line 36. The claimed process for the preparation of the compounds is disclosed in the examples mentioned above.

Claims 1 to 3, 5, 7 to 10 and 12 to 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Russ et al. (US 7026458), cited.

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The reference discloses the claimed compound of the formula (1) wherein B and B' are SO₃H and are ortho to the diazo bridge; Q is an unsubstituted C₂ alkylene group; R, R', R'' and R''' are each H; and X and X' are each Cl. Note Compound (IIa) in columns 11 and 12. The reference also discloses that the compound can be used for dyeing or printing hydroxy- and/or nitrogen-containing substrates such as cotton and in the preparation of inks. Note column 4, line 51 to column 6, line 6.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 to 10 and 12 to 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carr (GB 2331757).

Determination of the scope and content of the prior art (MPEP §2141.01)

The reference discloses structurally similar compounds that are used as dyes for dyeing and printing hydroxy- and/or nitrogen-containing substrates such as cotton, wool and paper

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and in the preparation of inks. The compounds of the reference are structurally similar to the claimed compounds of the formula 1 wherein B and B' are SO₃H and are ortho to the diazo bridge; Q is an alkylene group; R, R', R'' and R''' are each H; and X and X' are each a labile atom or group such as Cl or F. Note Example 2, in particular where Z¹ IS Cl and Dye Nos. 2-4, 10 and 11 of Table 1, and Tables 2 and 3. The reference also discloses that the compounds can be used for dyeing or printing hydroxy- and/or nitrogen-containing substrates such as cotton, wool and paper and in the preparation of inks. Note the abstract and page 13, lone 35 to page 14, line 36. The claimed process for the preparation of the compounds is disclosed in the examples mentioned above and on page 8, line 29 to page p, line 30.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The compounds of the reference differ from those claimed in that the group that corresponds to Q of the instant invention is alkylene that is interrupted by more than one oxygen atom instead of an unsubstituted or substituted alkylene group or an unsubstituted or substituted alkyl polyamine group comprising one or more nitrogen atoms and/or in that the groups that correspond to X and X' of the present invention are Cl instead of F, for example.

Finding of prima facie obviousness---rational and motivation (MPEP §2142-2413)

The reference discloses the interchangeability of the abovementioned linking groups that correspond to instant Q. Note the definition of Q, X¹, X² and L on page 2, lines 15 to 36, and page 3, lines 6 to 14. Also note the definition of Z¹ and Z² on page 4, line 32 to page 5, line 2. One of ordinary skill in the art would have been motivated to make the claimed compounds with the expectation that additional compounds useful for dyeing and printing substrates and as inks would be obtained.

Claims 1 to 10 and 12 to 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russ et al. (US 7026458).

Determination of the scope and content of the prior art (MPEP §2141.01)

The reference discloses dyestuff mixtures that contain compounds of instant formula 1 wherein B and B' are SO₃H and are ortho to the diazo bridge; Q is an unsubstituted C₂ alkylene group; R, R', R'' and R''' are each H; and X and X' are each Cl. Note Example 2 in column 10 to column 14, line 2, especially Compound (IIa) in columns 11 and 12. The reference also discloses that the mixtures can be used for dyeing or printing hydroxy- and/or nitrogen-containing substrates such as cotton and in the preparation of inks. Note column 4, line 51 to column 6, line 6. The reference discloses that the dyestuffs of the formula (II) of the reference can be prepared by analogy to

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the method given for the preparation of the compounds of the formula (I). Note column 3, line 25 to column 4, line 34.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The prior art differs from the claimed invention in that the compound that corresponds to instant formula 1 is disclosed in a dyestuffs mixture instead of being used by itself and may also differ in that the group that corresponds to instant X and X' are Cl instead of F.

Finding of prima facie obviousness---rational and motivation (MPEP §2142-2413)

It is obvious to use separately compounds that are used in a mixture. See *In re Kerkoven*, 205 USPQ 1069. The reference itself discloses the interchangeability of labile groups such as Cl and F. Note formula (II) in column 2 and the definition of X³ and X⁴ in column 2, lines 25 and 28 to 31. One of ordinary skill in the art would have been motivated to make the claimed compounds with the expectation that additional compounds useful for dyeing or printing hydroxy- and/or nitrogen-containing substrates such as cotton and in the preparation of inks would be obtained. The claimed process of dyeing and printing, process for preparation of the compounds and substrates and inks would have also been rendered obvious in the absence of any unobvious property or result.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fiona T. Powers whose telephone number is 571-272-0702. The examiner can normally be reached on Monday - Friday 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fiona T. Powers/
Primary Examiner, Art

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May 30, 2009